

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicant: Ethan J. Bernstein et al. Examiner: Ries, Laurie Anne
Serial No.: 10/693,347 Group Art Unit: 2176
Filed: October 24, 2003 Docket: 60001.0278US01/MS304257.1
Confirmation No.: 2716 Notice of Allow. Date: n/a
Due Date: n/a
Title: Method and Apparatus for Merging Electronic Documents Containing Markup Language

CERTIFICATE UNDER 37 CFR 1.8:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on August 21, 2006.

By: *Merri D. Cruz*
Name: Merri D. Cruz

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

27488

PATENT TRADEMARK OFFICE

Sir:

We are transmitting herewith the attached:

- ☒ Transmittal Sheet in duplicate containing Certificate of Mailing
- ☒ Second Supplemental Information Disclosure Statement
- ☒ Charge Deposit Account No. 13-2725 in the amount of \$180.00 for Submission of Information Disclosure Statement Fee
- ☒ Return postcard

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers or any future reply, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate of this sheet is enclosed.

Merchant & Gould LLC
P.O. Box 2903
Minneapolis, MN 55402-0903
404.954.5100

By: *D. Kent Stier*
Name: D. Kent Stier
Reg. No.: 50,640
DKS:mdc



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By:

Name: Merri D. Cruz

SECOND SUPPLEMENTAL INFORMATION DISCLOSURE
STATEMENT (37 C.F.R. §1.97(c))

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

This statement should be considered because it is submitted after the mailing date of a first Office Action on-the-merits or a first Office Action after filing a Request for Continued Examination under 37 C.F.R. § 1.114, but before the mailing date of: i) a final action under 37 C.F.R. § 1.113; ii) a Notice of Allowance under 37 C.F.R. § 1.311; or iii) an action that otherwise closes prosecution on the application. Please charge Deposit Account No. 13-2725 in the amount of \$180.00 under 37 C.F.R. § 1.17(p) for filing of the Information Disclosure Statement.

At least some of the features disclosed in the patent application identified above (hereinafter "the Application") may have been included in a beta release of Microsoft Office software, which occurred in October 2002. Therefore, it is possible some of the system code incorporating the described implementations was disclosed to a controlled set of users more than one year before the filing date of the Application. This beta release of the Office software,

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which was conducted for testing purposes, included approximately five thousand users. It is significant to note that the beta release was distributed to a fixed number of users, and each user acknowledged a Microsoft non-disclosure agreement. The non-disclosure agreement included the following clause:

7. CONFIDENTIALITY. The Product, including its existence and features, and related information are proprietary and confidential information to Microsoft and its suppliers. Recipient agrees not to disclose or provide the Product, documentation, or any related information (including the Product features or the results of use or testing) to any third party, prior to commercial release of the Product. However, Recipient may disclose confidential information in accordance with judicial or other governmental order, provided Recipient shall give Microsoft reasonable written notice prior to such disclosure and shall comply with any applicable protective order or equivalent. Further, Recipient shall not be liable to Microsoft for disclosure of information which Recipient can prove (a) is already known to Recipient without an obligation to maintain the same as confidential; (b) becomes publicly known through no wrongful act of Recipient; (c) is rightfully received from a third party without breach of an obligation of confidentiality owed to Microsoft; or (d) is independently developed by Recipient. The obligations of this Section 7 are in addition to the terms of any confidentiality or non-disclosure agreement that may exist between Microsoft and Recipient.

Since the beta release was distributed to a fixed number of users that acknowledged the above confidentiality clause, Applicants believe submission of the claims in the Application is proper.

No representation is made that a reference is "prior art" within the meaning of 35 U.S.C. §§ 102 and 103 and Applicants reserve the right, pursuant to 37 C.F.R. § 1.131 or otherwise, to establish that the reference(s) are not "prior art." Moreover, Applicants do not represent that a

reference has been thoroughly reviewed or that any relevance of any portion of a reference is intended.

Consideration of the information contained herein is respectfully requested. Pursuant to the provisions of M.P.E.P. 609, it is requested that the Examiner return a copy of the present Information Disclosure Statement, marked as being considered and initialed by the Examiner, to the undersigned with the next official communication.


Please charge any additional fees or credit any overpayment to Deposit Account No. 13-2725.

Respectfully submitted,
MERCHANT & GOULD P.C.

P.O. Box 2903
Minneapolis, MN 55402-0903
404.954.5066

Date: August 21, 2006

DKS:mdc



D. Kent Stier
Reg. No. 50,640

